

REMARKS

Summary of the Examiner's Actions

The examiner indicated that the present application contains claims directed to the following patentably distinct species of the claimed invention:

Species I – Figure 3;

Species II – Figure 4;

Species III – Figure 5;

Species IV – Figure 10;

Species V – Figure 11.

Accordingly, the examiner, pursuant to 35 U.S.C. § 121, has required restriction of the application to a single species. Additionally, the examiner has requested that Applicant identify the claims readable on whichever single species he elects for examination on the merits. Applicant acknowledges the examiner's restriction requirement.

Restriction Requirement

An application containing two or more "independent and distinct" inventions may be restricted to a single invention. 35 U.S.C. § 121 (2000). Section 808 of the Manual of Patent Examining Procedure (MPEP), which provides further detail, states as follows:

Every requirement to restrict has two aspects:

(A) the reasons (as distinguished from the mere statement of conclusion) why each invention *as claimed* is either independent or distinct from the other(s); and

(B) the reasons why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons for insisting upon restriction therebetween as set forth in the following sections.

(Underlining added; emphasis in original.)

Regarding the first of the two aspects, Section 802.01 of the MPEP provides that inventions are independent if they are “unconnected in design, operation, and effect.” MPEP § 802.01 (2005). Even if related, two inventions that are “not connected in at least one of design, operation, or effect … and wherein one invention is patentable … over the other” are distinct. *Id.*

In the present application, the examiner stated:

This application contains claims directed to the following patentably distinct species: Species I - Figure 3, Species II - figure 4, Species III - figure 5, Species IV - Figure 10, Species V - figure 11.

Office Action, pg. 2 (May 11, 2006). Thus, the examiner has not provided any reasons, as distinguished from mere statements of conclusion, as to why each of the five alleged species is distinct. In the absence of any such reasons, Applicant respectfully contends that a *prima facie* case that restriction of the application is proper has not been established. Consequently, Applicant does not have any indication of why the examiner considers the species distinct. As a result, Applicant’s ability to respond meaningfully to the examiner’s concerns has been adversely affected.

In light of the foregoing, Applicant does respectfully submit that each of the independent claims, *i.e.*, Claims 1, 11, 19, 24, 31, 35, and 41 are merely different definitions of a single invention and not patentably distinct species.

Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are not directed to distinct inventions; rather they are different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

MPEP § 806.03 (2005) (emphasis in original). Although Claims 1, 11, 19, 24, 31, 35, and 41 vary in breadth and/or scope, each claim defines common essential characteristics of a single embodiment of the invention. All of the claims relate to a single invention, *i.e.*, an apparatus or sensor for sensing an occupant in a vehicle, as part of a vehicle

occupant restraint system. All of the claims have common elements, and a single field of search will locate the relevant prior art.

Finally, still regarding the first aspect, the examiner has not satisfied the requirements set forth in Section 808.02 of the MPEP. Specifically, the examiner has failed to show by appropriate explanation one of the following: (1) the subject matters of each of the alleged species have attained recognition in the art as separate subjects for inventive effort, (2) even though they are classified together, the subject matters of each of the alleged species have formed separate subjects for inventive effort, or (3) it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists. *See* MPEP § 808.02 (2005).

Accordingly, on the basis of the foregoing, Applicant respectfully submits that the restriction requirement is improper because the examiner has not established that the claims in the present application relate to distinct inventions.

Regarding the second aspect, the examiner has not provided any reasons as to why searching all of the claims would seriously burden her. *See* MPEP § 808. Accordingly, Applicant respectfully submits that, on this basis, the restriction requirement is improper.

Additionally, Section 803 of the MPEP states:

If the search and examination of all the claims in an application can be made without serious burden, the examiner *must* examine them on the merits, even though they include claims to independent or distinct inventions.

(Emphasis added). Because the claims of the present application have common subject matter and vary only in scope and/or breadth, the search and examination of the claims in the present application can be accomplished without imposing a serious burden on the examiner. Accordingly, Applicant respectfully submits, in the alternative, that the restriction requirement is improper because the examiner would not be seriously burdened by examining all of the claims present in the application.

Conclusion

Applicant respectfully submits that the restriction requirement in the present application is improper because all claims therein are directed to a single invention. The examiner has not established that (1) the inventions are independent and distinct and (2) examination of all claims would result in a serious burden. Accordingly, it is respectfully requested that the restriction requirement be withdrawn, and the withdrawn claims reentered and examined on the merits.

In order to make a complete reply, Applicant elects Species II, which he identifies as Claims 1-6, 8-16, 18, 24-25, 27-32, 34-39, and 41. Accordingly, Claims 7, 17, 19-23, 26, 33, and 40 have been withdrawn. Applicant makes this election with traverse.

Please charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 16-1910 (28540.00).

Respectfully submitted,

PITTS & BRITTIAN, P.C.

/Ken Hoffmeister/

by: J. Kenneth Hoffmeister
Registration Number 43,675

PITTS AND BRITTIAN, P.C.
P.O. Box 51295
Knoxville, Tennessee 37950-1295
(865) 584-0105 Voice
(865) 584-0104 Fax